

Serial No: 08/870,199
Filed: June 5, 1997
Docket: 1650B US

REMARKS

Claims 1-58 are pending in the present application. By her Office Action dated March 02, 2005, the Examiner has rejected claims 13, 25, 27 and 31-58 as being "improper as presented. Claims 13 and 25 do not show differences from original patent by underlining and bracketing. Claims 27-58 must be entirely underlined, as they are new claims to the original patent."

Applicant respectfully directs the Examiner to Applicant's Amendment dated April 16, 1999, specifically to page 2 of that Amendment, in which this issue was specifically addressed with regards to Claims 13 and 25. In particular, the Examiner had directed that attorney Barry Copeland, then prosecuting the present application, contact Special Examiner William Dixon regarding the form of the amendments to Claims 1, 13 and 25. Special Examiner Dixon stated, in a phone conversation with Attorney Copeland and as outlined in Applicant's April 16, 1999 amendment, that "there was no need to insert the parenthetical expression "amended" in those claims when the amendments are being effected with the filing of the application for reissue. He said the bracketing of omitted text and the interlineation of new text constituted appropriate amendment form, provided the requested amendments were readily legible." Applicant therefore believes that claims 13 and 25 have been properly presented and request the Examiner withdraw this rejection and allow claims 13 and 25.

In an attempt to further the prosecution of this case and comply with the Examiner's request, Applicant has re-presented claims 27-58 with the underlining required by the Examiner. Applicant is unclear, however, whether claims 27-58 should be labeled with the status identifier "new", "previously presented" or "original" and requests the Examiner's opinion on this issue. As the claims have been previously presented, though perhaps improperly as suggested by the Examiner, Applicant will continue to identify claims 27 and 31-58 as "previously presented". Because claims 28-30 are in their originally presented form in this reissue application,

Serial No: 08/870,199
Filed: June 5, 1997
Docket: 1650B US

Applicant will maintain the identifier for claims 28-30 as "original". The underlining of claims 27-58 constitutes the only "amendment" of the present Application under this response.

The Examiner also rejected claims 57 and 58 under 5 U.S.C. 251 as "being broadened in a reissue application filed outside the two year statutory period. Claims 57 and 58 are improperly broadened." In this regard, Applicant respectfully traverses and directs the Examiner's attention to Applicant's May 9, 2002 Response and Amendment and January 24, 2003 Response and Amendment. For the same reasons stated in these Response and Amendments, which reasons are incorporated herein, Applicant respectfully submits that removing the "greater than 0.5 μ m in diameter" limitation is permissible. Applicant continues to maintain that the "0.5 μ m" limitation is not critical to patentability and that it was never characterized as such during the prosecution leading to the issuance of Patent No. 5,422,376 (the original patent).

During the course of the prosecution of this reissue application, Applicant amended the claims to replace the 0.5 μ m limitation with a requirement that the viscoelastic material be free of "harmful particulate matter." The claims as thus amended, however, have met with rejections from the Patent Office, the basis for which Applicant respectfully continues to dispute. Nevertheless, in view of these rejections, Applicant, in an attempt to move this protracted prosecution forward, reintroduced the 0.5 μ m limitation through Applicant's Amendment dated January 24, 2003. As part of this same Amendment, Applicant submitted the Supplemental Declaration of Bradford C. Webb, the sole inventor. The contents of Mr. Webb's Declaration are by this reference incorporated herein.

By his Declaration, Mr. Webb confirms that the amendments just discussed were designed to address the errors identified in his original 1997 Declaration. He also notes that claims 57 and 58 do not contain the 0.5 μ m limitation, but rather are limited to blended material corresponding to dependent claims 6 and 10 of the originally issued patent. In the sense that these claims require two different molecular

Serial No: 08/870,199
Filed: June 5, 1997
Docket: 1650B US

weight hydroxypropylmethylcellulose materials blended together to yield a resultant material having a specific zero shear viscosity and average molecular weight, these claims are narrower than the corresponding independent claims of the issued patent. In view of these narrowing limitations, introduction of the 0.5 μ m limitation is unnecessary. No new matter has been added.

The Examiner objected to claims 14-23, and 28-30 as being dependent on a rejected claim. As Claims 13 and 27, from which these sets of claims respectfully depend, are now considered by Applicant to be in condition for allowance, Applicant respectfully requests the Examiner withdraw her objection and also allow claims 14-23 and 28-30.

Applicant respectfully submits, therefore, that in view of the preceding remarks and arguments, the Examiner's basis for rejecting the pending claims has been overcome, and that all claims are now in condition for allowance. Applicant therefore respectfully requests allowance of all pending claims. Please direct any questions concerning the foregoing to the undersigned.

Respectfully submitted,



Armando Pastrana, Jr., Reg. 44,997
Telephone: (817) 615-5056
Facsimile: (817) 551-4610

Address for Correspondence:

Armando Pastrana, Jr.
IP Legal, Mail Code Q-148
Alcon Research, Ltd.
6201 South Freeway
Fort Worth, TX 76134-2099

Docket No. 1560B US